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IN THE UNITED STATES PATENT AND TRADEMARK
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Atty. Ref. No.: 016756/0211

BFS BRANDS, LLC

and

BRIDGESTONE/FIRESTONE
NORTH AMERICAN TIRE, LLC,

Opposers,

v.

ORTECK INTERNATIONAL INC.,

Applicant.

Opposition No. 154,661

Application Serial No. 76/369,339



11-29-2004

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #66

TRANSMITTAL LETTER

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Madam:

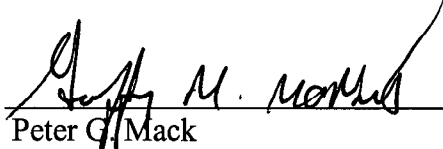
Please find attached hereto the following items, in duplicate:

1. Opposers' Consented Motion for Leave to Amend Notice of Opposition;
2. Second Amended Notice of Opposition (original);
3. Second Amended Notice of Opposition (black-line format).

Should any additional fees become due, please charge them to Foley & Lardner LLP's
Deposit Account No. 19-0741.

Respectfully submitted,

November 29, 2004

By: 
Peter G. Mack
Geoffrey McNutt
Counsel for Opposers

FOLEY & LARDNER LLP
Suite 500
3000 K St., N.W.
Washington, D.C. 20007
202-672-5300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BFS BRANDS, LLC

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NORTH AMERICAN TIRE, LLC,

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ORTECK INTERNATIONAL INC.,

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Opposition No. 154,661

Application Serial No. 76/369,339

OPPOSERS' CONSENTED TO MOTION FOR LEAVE TO AMEND
NOTICE OF OPPOSITION

Opposers BFS Brands, LLC and Bridgestone/Firestone North American Tire, LLC (hereinafter referred collectively as "Opposers") hereby move this Board, pursuant to Trademark Rule § 2.107 and Fed. R. Civ. P. 15, for leave to amend their Notice of Opposition in order to include U.S. Registration Nos. 1,113,091 to their grounds for opposition and to dismiss, without prejudice, their dilution claim. Opposers, in their proposed Second Amended Notice of Opposition, also seek to update their pleading to reflect their change of address; to delete two registrations (Reg. Nos. 299,977 and 1,685,164) that have lapsed since the initial filing of the opposition; and to indicate that previously pleaded Application No. 75/768,214 has matured to registration as U.S. Registration No. 2,813,281.

Applicant's attorney, Deborah J. Westervelt, has consented to the proposed amendments and has also consented to dismissal of the dilution claim without prejudice.

A copy of Opposers' proposed Second Amended Notice of Opposition together with the required fee is enclosed herewith. For the convenience of the Board, a red-lined copy of the Second Amended Notice of Opposition tracking the proposed changes is also enclosed.

The proposed amendments do not affect the testimony and other evidence to be submitted in this case; hence no change in the current scheduling order is needed or sought.

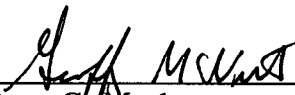
WHEREFORE, Opposers respectfully request that this motion be granted and that the proposed Second Amended Notice of Opposition be accepted and entered.

Respectfully submitted,

BFS Brands, LLC and

Bridgestone/Firestone North American Tire, LLC


Date : November 29, 2004

By: 
Peter G. Mack
Geoffrey M. McNutt
Foley & Lardner, LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Tel: (202) 672-5300
Fax: (202) 672-5399
Attorneys for Opposers

CERTIFICATE OF SERVICE

I hereby certify that I have this 29th day of November, 2004, served a true and complete copy of the foregoing OPPOSERS' CONSENTED MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION upon Applicant by mailing a true copy of the same via first-class U.S. Mail, postage prepaid, to Applicant's counsel, addressed as follows:

Deborah J. Westervelt, Esq.
The Law Offices of Royal J. Craig
10 North Calvert Street
Suite 153
Baltimore, Maryland 21202

By: 
Geoffrey M. McNutt
FOLEY & LARDNER, LLP
Attorney for Opposers

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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v.

ORTECK INTERNATIONAL INC.,

Applicant.

Opposition No. 154,661

Application Serial No. 76/369,339

SECOND AMENDED NOTICE OF OPPOSITION

This is in the matter of an application for registration of the expression "MILESTONE ROAMER" for "tires for vehicle wheels", Serial No. 76/369,339, filed February 8, 2002 by Orteck International, Inc., having a business address at 1621B Iron Bridge Road, Jessup, Maryland 20794 (hereinafter called "Applicant"), and published for opposition in the *Official Gazette* of July 30, 2002.

BFS Brands, LLC, a Delaware limited liability company, having a business address at 535 Marriott Drive, Nashville, Tennessee 37214, and Bridgestone/Firestone North American Tire, LLC, a Delaware limited liability company, having a business address at 535 Marriott Drive,

Nashville, Tennessee 37214, believe that they would be damaged by registration of the mark in the foregoing application and hereby oppose the same.

The grounds for the opposition are as follows:

1. BFS Brands, LLC, and Bridgestone/Firestone North American Tire, LLC, (hereinafter referred to collectively as "Opposers") are wholly owned subsidiaries of Bridgestone/Firestone Americas Holding, Inc., and trace their ultimate origin to The Firestone Tire & Rubber Company (hereinafter called "Firestone").

2. By the application herein opposed, Applicant seeks to register "MILESTONE ROAMER" as a trademark for "tires for vehicle wheels", basing such application for United States federal registration on an intent to use the mark in commerce in connection with the identified goods. The constructive date of first use of Applicant's mark is the filing date of Applicant's application, February 8, 2002.

3. Opposers, as the successors in interest to Firestone, are the owner of all right, title and interest in and to various FIRESTONE marks for vehicle tires and for other goods and services. As used herein, "Opposers' goods," "Opposers' services," and "Opposers' business," as well as expressions to a similar effect, mean the goods, the services and the business of Firestone, which is the ultimate predecessor in title of Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC.

4. Opposer BFS Brands, LLC, is the owner of many U.S. Trademark and Service Mark Registrations featuring the mark FIRESTONE. Among such U.S. registrations are Reg. No.

140,804, registered March 29, 1921, for the mark FIRESTONE in a stylized form for rubber tires and other products, which registration is still in full force and effect. Other such U.S. registrations include Reg. No. 378,189; Reg. No. 396,796; Reg. No. 401,421; Reg. No. 948,402; Reg. No. 1,178,631; Reg. No. 1,387,468; Reg. No. 1,445,182; Reg. No. 1,471,665; Reg. No. 2,223,630; Reg. No. 2,464,005; Reg. No. 2,507,769; Reg. No. 2,582,878; Reg. No. 2,813,281; and Reg. No. 1,113,091 for STONES.

5. Opposer Bridgestone/Firestone North American Tire, LLC, uses the registered FIRESTONE marks owned by Opposer BFS Brands, LLC, with the authorization of the latter entity.

6. The term FIRESTONE was adopted as a mark and name by The Firestone Tire & Rubber Company, the ultimate predecessor of both Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC, more than one hundred years ago, in January, 1896. The FIRESTONE mark and name has been used continuously since then to the present in connection with the advertising, promotion, sale and offering of Opposers' tires and other goods in interstate commerce; and is still in such use by Opposers.

7. Opposers use trade names and corporate identifiers dominated by the name "Bridgestone/Firestone." Such Bridgestone/Firestone name and identifier have been in use since long prior to any date on which Applicant may rely in this proceeding. In this regard, the ultimate parent company of Opposers is Bridgestone Corporation; and the mark and name BRIDGESTONE is often used with the mark and name FIRESTONE to create a unitary impression conveyed by a composite of the two marks and names BRIDGESTONE and FIRESTONE. Also, Firestone has a website accessed, not only by its domain name <firestone.com>, but also by its domain name

<bridgestone-firestone.com>. Thus, as used herein, the expression "Bridgestone/Firestone name" and expressions to the same effect encompass the aforesaid Bridgestone/Firestone trade name and corporate identifier, the aforesaid composite expression composed of the terms BRIDGESTONE and FIRESTONE, and the aforesaid <bridgestone-firestone.com> domain name.

8. The FIRESTONE names and marks and the Bridgestone/Firestone name are of significant value to Opposers as identifications of source in connection with the promotion, sale, rendering and offering of the goods and services of Opposers and their affiliates, as well as in the conducting and identifying of the business of Opposers and its affiliates; and such marks and names distinguish such goods, such services and such business from those of others.

9. Opposers and their affiliates have been using the FIRESTONE names and marks as well as the Bridgestone/Firestone name in connection with their goods, services, and businesses since long prior to any date on which Applicant may rely in this proceeding, namely, well before the filing date of the application herein opposed.

10. The FIRESTONE names and marks for "rubber tires" and for other goods and services, as well as the Bridgestone/Firestone name, on the one hand, and the "MILESTONE ROAMER" mark as sought to be registered by Applicant for "tires for vehicle wheels", on the other hand, are similar in sight, sound, spelling and appearance. Thus, the mark sought to be registered by Applicant so resembles the marks and names of Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC, as to be likely to cause confusion, or to cause mistake, or to deceive.

11. The "tires for vehicle wheels" identified by the Applicant's designation "MILESTONE ROAMER" and the "rubber tires" identified by Opposers' FIRESTONE marks and names and by the Bridgestone/Firestone name are identical. Applicant's goods and Opposers' goods and other services and businesses are closely related kinds of goods, services and businesses and are typically offered and provided to the same classes of purchasers through the same channels of trade.

12. Through use and promotion by Opposers and their affiliates of Opposers' FIRESTONE marks and names and of the Bridgestone/Firestone name for Opposers' goods, services and businesses, purchasers and prospective purchasers of such goods and services and/or of goods and services of the same general kind, as well as customers and prospective customers of such businesses, associate such marks with the goods, services and business of Opposers.

13. Purchasers and prospective purchasers familiar with Opposers' goods, services and businesses identified by the FIRESTONE marks and names and by the Bridgestone/Firestone name are likely to be misled into believing, contrary to fact, that Applicant's goods sold under the mark opposed herein emanate from or are in some way sponsored by Opposers or their affiliates, all to Opposers' irreparable damage through loss of their good will as symbolized by Opposers' marks and names.

14. Granting of a registration as sought by Applicant through the application herein opposed would place Applicant in a position to harass and cause annoyance to Opposers and their customers, to the damage of Opposers. Such registration would inhibit Opposers in their free use of their FIRESTONE marks and names and their Bridgestone/Firestone name in selling their products, promoting their services, and conducting their business, which would work manifest damage upon

Opposers. Finally, such registration would constitute *prima facie* evidence of an exclusive right to use the designation "MILESTONE ROAMER" for the goods designated in the application herein opposed and for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of Opposers.

15. In view of extensive promotion and use thereof for more than a century and in view of the widespread renown and recognition thereby developed, Opposers' FIRESTONE marks and names have long been famous marks and names. The Bridgestone/Firestone name is also famous. Such marks and names have been famous since long before any date on which Applicant may rely for priority purposes in this proceeding.

16. For at least the above reasons, registration of Applicant's Serial No. 76/369,339 is herein opposed on the grounds that Applicant's proposed MILESTONE ROAMER mark so resembles Opposers' FIRESTONE marks and names and the Bridgestone/Firestone name as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and under state statutory law and common law.

17. Registration of the mark shown in the subject application is also opposed on the grounds that Applicant does not own any trademark rights in the designation MILESTONE ROAMER.

18. Tires bearing the designation MILESTONE ROAMER are manufactured in China by a company that is unrelated to the Applicant.

19. Although the subject Application was filed based on intent to use, tires bearing the designation MILESTONE ROAMER are presently sold in the U.S.

20. Applicant's customers are tire wholesalers and/or tire distributors located in the United States. Applicant receives orders for tires from its customers and then passes the orders on to its Chinese supplier.

21. Tires are then shipped directly from the Chinese supplier to Applicant's customer.

22. Except in rare circumstances, Applicant does not actually see the physical tires that are shipped to its customers, and is not in a position to observe or control the manufacture or quality of the tires.

23. Applicant never has had and still does not have any influence over or input into the specifications of the tires.

24. Even when MILESTONE or MILESTONE ROAMER brand tires are specified in the purchase order sent by Applicant to the Chinese supplier, Applicant does not know and has no control over what brand of tire is or will be shipped from the Chinese supplier directly to Applicant's customers. The actual brand shipped is often a brand other than the MILESTONE or MILESTONE ROAMER brand that was ordered.

25. For these reasons, registration of the designation MILESTONE ROAMER mark is also opposed on the grounds that the application is void *ab initio* because Applicant is not the owner of the mark within the meaning of section 1 of the Lanham Act, 15 U.S.C. § 1051, and is therefore not entitled to use or register the mark.

26. Alternatively, in the event that the Board were to determine that Applicant owns the mark, registration is opposed on the ground that Applicant abandoned any proprietary trademark rights it may have once possessed by failing to exercise any control whatsoever over both the use of the mark and the nature and quality of goods bearing the mark.

27. Additionally, because Applicant has never exercised any control over the use of the designation MILESTONE ROAMER or the nature and quality of goods bearing the designation MILESTONE ROAMER, registration is opposed on the grounds that the application is void *ab initio* because at the time Applicant filed its application it did not have a bona fide intent to use the wording MILESTONE ROAMER in U.S. commerce in the manner of a trademark, within the meaning of Section 1 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1127.

WHEREFORE, Opposers request that this opposition be sustained and the subject application Serial No. 76/369,339 to register the mark MILESTONE ROAMER be refused registration.

Respectfully submitted,

BFS Brands, LLC and

Bridgestone/Firestone North American Tire, LLC

Date : November 29, 2004

By: 

Peter G. Mack

Geoffrey M. McNutt

Foley & Lardner, LLP

Washington Harbour

3000 K Street, N.W., Suite 500

Washington, D.C. 20007-5109

Tel: (202) 672-5300

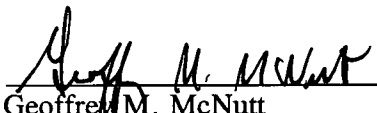
Fax: (202) 672-5399

Attorneys for Opposers

CERTIFICATE OF SERVICE

I hereby certify that I have this 29th day of November 2004, served a true and complete copy of the foregoing SECOND AMENDED NOTICE OF OPPOSITION upon Applicant by mailing a true copy of the same via first-class U.S. Mail, postage prepaid, to Applicant's counsel, addressed as follows:

Deborah J. Westervelt, Esq.
The Law Offices of Royal J. Craig
10 North Calvert Street
Suite 153
Baltimore, Maryland 21202

By: 
Geoffrey M. McNutt
FOLEY & LARDNER, LLP

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and	:	
	:	
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NORTH AMERICAN TIRE, LLC,	:	Opposition No. 154,661
	:	
Opposers,	:	
	:	Application Serial No. 76/369,339
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	:	
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	:	
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BFS Brands, LLC, a Delaware limited liability company, having a business address at ~~50 Century Blvd.~~ 535 Marriott Drive, Nashville, Tennessee 37214, and Bridgestone/Firestone North American Tire, LLC, a Delaware limited liability company, having a business address at 4

~~Bridgestone Park~~535 Marriott Drive, Nashville, Tennessee 37214, believe that they would be damaged by registration of the mark in the foregoing application and hereby oppose the same.

The grounds for the opposition are as follows:

1. BFS Brands, LLC, and Bridgestone/Firestone North American Tire, LLC, (hereinafter referred to collectively as "Opposers") are wholly owned subsidiaries of Bridgestone/Firestone Americas Holding, Inc., and trace their ultimate origin to The Firestone Tire & Rubber Company (hereinafter called "Firestone").

2. By the application herein opposed, Applicant seeks to register "MILESTONE ROAMER" as a trademark for "tires for vehicle wheels", basing such application for United States federal registration on an intent to use the mark in commerce in connection with the identified goods. The constructive date of first use of Applicant's mark is the filing date of Applicant's application, February 8, 2002.

3. Opposers, as the successors in interest to Firestone, are the owner of all right, title and interest in and to various FIRESTONE marks for vehicle tires and for other goods and services. As used herein, "Opposers' goods," "Opposers' services," and "Opposers' business," as well as expressions to a similar effect, mean the goods, the services and the business of Firestone, which is the ultimate predecessor in title of Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC.

4. Opposer BFS Brands, LLC, is the owner of many U.S. Trademark and Service Mark Registrations featuring the mark FIRESTONE. Among such U.S. registrations are Reg. No.

140,804, registered March 29, 1921, for the mark FIRESTONE in a stylized form for rubber tires and other products, which registration is still in full force and effect. Other such U.S. registrations include Reg. No. ~~299,977~~; Reg. No. ~~378,189~~; Reg. No. 396,796; Reg. No. 401,421; Reg. No. 948,402; Reg. No. 1,178,631; Reg. No. 1,387,468; Reg. No. 1,445,182; Reg. No. 1,471,665; Reg. No. ~~1,685,164~~; Reg. No. ~~2,223,630~~; Reg. No. 2,464,005; Reg. No. 2,507,769; and Reg. No. ~~2,582,878~~; 2,582,878; Reg. No. 2,813,281; and Reg. No. 1,113,091 for STONES.

~~5. Bridgestone/Firestone North American Tire, LLC owns App. No. 75/768,214 featuring the mark FIRESTONE, which has already successfully completed the opposition phase and for which a Notice of Allowance has issued. App. No. 75/768,214 was filed on August 5, 1999 and therefore has a constructive date of first use prior to any date upon which Applicant may rely in this proceeding.~~

5. ~~6.~~ Opposer Bridgestone/Firestone North American Tire, LLC, uses the registered FIRESTONE marks owned by Opposer BFS Brands, LLC, with the authorization of the latter entity.

6. ~~7.~~ The term FIRESTONE was adopted as a mark and name by The Firestone Tire & Rubber Company, the ultimate predecessor of both Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC, more than one hundred years ago, in January, 1896. The FIRESTONE mark and name has been used continuously since then to the present in connection with the advertising, promotion, sale and offering of Opposers' tires and other goods in interstate commerce; and is still in such use by Opposers.

7. ~~8.~~—Opposers use trade names and corporate identifiers dominated by the name “Bridgestone/Firestone.” Such Bridgestone/Firestone name and identifier have been in use since long prior to any date on which Applicant may rely in this proceeding. In this regard, the ultimate parent company of Opposers is Bridgestone Corporation; and the mark and name BRIDGESTONE is often used with the mark and name FIRESTONE to create a unitary impression conveyed by a composite of the two marks and names BRIDGESTONE and FIRESTONE. Also, Firestone has a website accessed, not only by its domain name <firestone.com>, but also by its domain name <bridgestone-firestone.com>. Thus, as used herein, the expression “Bridgestone/Firestone name” and expressions to the same effect encompass the aforesaid Bridgestone/Firestone trade name and corporate identifier, the aforesaid composite expression composed of the terms BRIDGESTONE and FIRESTONE, and the aforesaid <bridgestone-firestone.com> domain name.

8. ~~9.~~—The FIRESTONE names and marks and the Bridgestone/Firestone name are of significant value to Opposers as identifications of source in connection with the promotion, sale, rendering and offering of the goods and services of Opposers and their affiliates, as well as in the conducting and identifying of the business of Opposers and its affiliates; and such marks and names distinguish such goods, such services and such business from those of others.

9. ~~10.~~—Opposers and their affiliates have been using the FIRESTONE names and marks as well as the Bridgestone/Firestone name in connection with their goods, services, and businesses since long prior to any date on which Applicant may rely in this proceeding, namely, well before the filing date of the application herein opposed.

10. ~~11.~~—The FIRESTONE names and marks for “rubber tires” and for other goods and services, as well as the Bridgestone/Firestone name, on the one hand, and the “MILESTONE ROAMER” mark as sought to be registered by Applicant for “tires for vehicle wheels”, on the other hand, are similar in sight, sound, spelling and appearance. Thus, the mark sought to be registered by Applicant so resembles the marks and names of Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC, as to be likely to cause confusion, or to cause mistake, or to deceive.

11. ~~12.~~—The “tires for vehicle wheels” identified by the Applicant’s designation “MILESTONE ROAMER” and the “rubber tires” identified by Opposers’ FIRESTONE marks and names and by the Bridgestone/Firestone name are identical. Applicant’s goods and Opposers’ goods and other services and businesses are closely related kinds of goods, services and businesses and are typically offered and provided to the same classes of purchasers through the same channels of trade.

12. ~~13.~~—Through use and promotion by Opposers and their affiliates of Opposers’ FIRESTONE marks and names and of the Bridgestone/Firestone name for Opposers’ goods, services and businesses, purchasers and prospective purchasers of such goods and services and/or of goods and services of the same general kind, as well as customers and prospective customers of such businesses, associate such marks with the goods, services and business of Opposers.

13. ~~14.~~—Purchasers and prospective purchasers familiar with Opposers’ goods, services and businesses identified by the FIRESTONE marks and names and by the Bridgestone/Firestone name are likely to be misled into believing, contrary to fact, that Applicant’s goods sold under the

mark opposed herein emanate from or are in some way sponsored by Opposers or their affiliates, all to Opposers' irreparable damage through loss-and/or dilution of their good will as symbolized by Opposers' marks and names.

14. ~~15.~~ Granting of a registration as sought by Applicant through the application herein opposed would place Applicant in a position to harass and cause annoyance to Opposers and their customers, to the damage of Opposers. Such registration would inhibit Opposers in their free use of their FIRESTONE marks and names and their Bridgestone/Firestone name in selling their products, promoting their services, and conducting their business, which would work manifest damage upon Opposers. Finally, such registration would constitute *prima facie* evidence of an exclusive right to use the designation "MILESTONE ROAMER" for the goods designated in the application herein opposed and for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of Opposers.

15. ~~16.~~ In view of extensive promotion and use thereof for more than a century and in view of the widespread renown and recognition thereby developed, Opposers' FIRESTONE marks and names have long been famous marks and names. The Bridgestone/Firestone name is also famous. Such marks and names have been famous since long before any date on which Applicant may rely for priority purposes in this proceeding. ~~Applicant's MILESTONE ROAMER mark, which is the subject of the application opposed herein, causes and will cause dilution of the distinctive quality of Opposers' famous FIRESTONE mark and name and of the Bridgestone/Firestone name, all to the further damage of Opposers.~~

~~17. The application opposed herein was filed on February 8, 2002, which was subsequent to January 16, 1996, the effective date of the federal anti dilution statute reflected in Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Accordingly, the application herein opposed is subject to being opposed on the ground that the mark sought to be registered dilutes the distinctive quality of Opposers' famous marks and names.~~

16. ~~18.~~ For at least the above reasons, registration of Applicant's Serial No. 76/369,339 is herein opposed on the grounds that Applicant's proposed MILESTONE ROAMER mark so resembles Opposers' FIRESTONE marks and names and the Bridgestone/Firestone name as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and under state statutory law and common law.

~~19. Additionally, registration of Applicant's MILESTONE ROAMER mark is opposed on the grounds that it will dilute the distinctive quality of opposers' FIRESTONE marks and names and the Bridgestone/Firestone name under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and under state anti dilution statutes.~~

17. ~~20.~~ Registration of the mark shown in the subject application is also opposed on the grounds that Applicant does not own any trademark rights in the designation MILESTONE ROAMER.

18. ~~21.~~ Tires bearing the designation MILESTONE ROAMER are manufactured in China by a company that is unrelated to the Applicant.

19. ~~22.~~ Although the subject Application was filed based on intent to use, tires bearing the designation MILESTONE ROAMER are presently sold in the U.S.

20. ~~23.~~ Applicant's customers are tire wholesalers and/or tire distributors located in the United States. Applicant receives orders for tires from its customers and then passes the orders on to its Chinese supplier.

21. ~~24.~~ Tires are then shipped directly from the Chinese supplier to Applicant's customer.

22. ~~25.~~ Except in rare circumstances, Applicant does not actually see the physical tires that are shipped to its customers, and is not in a position to observe or control the manufacture or quality of the tires.

23. ~~26.~~ Applicant never has had and still does not have any influence over or input into the specifications of the tires.

24. ~~27.~~ Even when MILESTONE or MILESTONE ROAMER brand tires are specified in the purchase order sent by Applicant to the Chinese supplier, Applicant does not know and has no control over what brand of tire is or will be shipped from the Chinese supplier directly to Applicant's customers. The actual brand shipped is often a brand other than the MILESTONE or MILESTONE ROAMER brand that was ordered.

25. ~~28.~~ For these reasons, registration of the designation MILESTONE ROAMER mark is also opposed on the grounds that the application is void *ab initio* because Applicant is not

the owner of the mark within the meaning of section 1 of the Lanham Act, 15 U.S.C. § 1051, and is therefore not entitled to use or register the mark.

26. ~~29.~~—Alternatively, in the event that the Board were to determine that Applicant owns the mark, registration is opposed on the ground that Applicant abandoned any proprietary trademark rights it may have once possessed by failing to exercise any control whatsoever over both the use of the mark and the nature and quality of goods bearing the mark.

27. ~~30.~~—Additionally, because Applicant has never exercised any control over the use of the designation MILESTONE ROAMER or the nature and quality of goods bearing the designation MILESTONE ROAMER, registration is opposed on the grounds that the application is void *ab initio* because at the time Applicant filed its application it did not have a bona fide intent to use the wording MILESTONE ROAMER in U.S. commerce in the manner of a trademark, within the meaning of Section 1 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1127.

application Serial No. 76/369,339 to register the mark MILESTONE ROAMER be refused registration.

Respectfully submitted,

BFS Brands, LLC and

Bridgestone/Firestone North American Tire, LLC

Date : ~~April 16,~~November 29, 2004

By: _____

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